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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,177	07/31/2003	Rence M. Kovales	RSW920000128US2	9830
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MARCIA L. DOUBET LAW FIRM PO BOX 422859 KISSIMMEE, FL 34742			EXAMINER PATEL, HEMANT SHANTILAL	
			ART UNIT	PAPER NUMBER
			2614	
			NOTIFICATION DATE	DELIVERY MODE
			01/15/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mld@mindspring.com

## Office Action Summary

Application No.

10/632,177

Applicant(s)

KOVALES ET AL.

Examiner

Hemant Patel

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,9,11,14,15,17,18,20-24,28,34,37,90 and 99-116 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,9,11,14,15,17,18,20-24,28,90 and 99-113, 116 is/are allowed.
- 6) ☒ Claim(s) 34,37,114 and 115 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Applicant Response dated October 16, 2007 to an Office Action dated July 17, 2007 is entered. Claims 1, 9, 11, 14-15, 17-18, 20-24, 28, 34, 37, 90, 99-116 are pending in this application.

### ***Response to Arguments***

2. Applicant's arguments filed October 16, 2007 have been fully considered but they are not persuasive.

3. Regarding claim 34, the Applicant has quoted multiple parts of Johnson reference and has argued that Johnson does not teach of playing voicemail message back to the called party but it is played back to the caller upon query from the caller (Remarks, pgs 14-16). The Examiner respectfully disagrees. Johnson specifically teaches that the message is not played back just in response to query but it is played back at predetermined time i.e. delayed or scheduled delivery to the called party as was well known in the art, and Johnson further teaches that a query is the act of establishing communication link for the purpose of receiving information i.e. the called party calling into the phone messaging system to retrieve voice message and in this instance called party is a caller to the phone messaging system as was well known in the art (col. 6, ll. 32-45). It was obvious for a caller to leave the segmented voicemail message with insertion of audio files for the called party into the phone messaging system and then the called party dials (query) into the phone messaging system to listen to the voicemail message. In response to applicant's argument that the voicemail message is for the

called party and is played back to the called party, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Thus, Johnson clearly teaches the claim limitations of creating segmented voicemail message with audio files inserted between voicemail message segments for the called party and playing back this segmented message with insertion of selected audio files to the called party.

#### ***Response to Amendment***

4. Applicant's arguments with respect to claims 34, 37, 114, 115 have been considered but are moot in view of the new ground(s) of rejection. The rejections are necessitated due to claim amendments.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 34, 37, 114, 115 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US Patent No. 5,434,910).

***Regarding claim 34,*** Johnson teaches of a method of enhancing voice mail messages for playback to a party, comprising:

creating a voice mail message for the party, by a caller using a telephone device (col. 4, ll. 14-22; user as a caller desiring to leave verbal message into the phone messaging system);

identifying, by the caller using the telephone device while creating the voice mail message, a plurality of message segments for segmenting the voice mail message (col. 4, ll. 64-col. 5, ll. 17; col. 10, ll. 28-36; using keypad to enter key sequences to mark a position in voice message);

selecting, by the caller using the telephone device, an audio file from among a plurality of available audio files to insert into the voice mail message between one or more selected pairs of successive ones of the message segments, such that the selected audio file is associated with the selected pair(s) of message segments (col. 4, ll. 64-col. 6, ll. 23; col. 10, ll. 16-col. 11, ll. 10; adding references to prerecorded audio files between message segments); and

inserting the selected audio file between the successive ones of the message segments in its associated pair(s) as the voice mail message is played back to the party (col. 6, ll. 46-col. 7, ll. 12; col. 11, ll. 11-col. 13, ll. 29).

Regarding the limitation of party for whom the message is created and to whom the message is played back (and applicant argument about Johnson that it is the caller to whom message is played back upon query), Johnson specifically teaches that the message is not played back just in response to query but it is played back at predetermined time i.e. delayed or scheduled delivery to the called party as was well known in the art, and Johnson further teaches that a query is the act of establishing communication link for the purpose of receiving information i.e. the called party calling into the phone messaging system to retrieve voice message and in this instance called party is a caller to the phone messaging system as was well known in the art (col. 6, ll. 32-45). It was obvious for a caller to leave the segmented voicemail message with insertion of audio files for the called party into the phone messaging system and then the called party dials (query) into the phone messaging system to listen to the voicemail message. Thus, Johnson clearly teaches the claim limitations of creating segmented voicemail message with audio files inserted between voicemail message segments for the called party and playing back this segmented message with insertion of selected audio files to the called party.

**Regarding claim 37**, Johnson teaches of inserting prerecorded audio file that includes names and phone numbers (col. 5, ll. 52-57; col. 6, ll. 60-col. 7, ll. 12)

**Regarding claim 114**, it recites a system performing a method substantially similar to the method as claimed in claim 34. Johnson teaches of such a system (Figs. 1-3 and the corresponding descriptions in the reference art). Refer to rejection for claim 34.

**Regarding claim 115**, refer to rejections for claim 114 and claim 37.

#### ***Allowable Subject Matter***

8. Claims 1, 9, 11, 14-15, 17-18, 20-24, 28, 90, 99-113, 116 allowed.

**Claim 1**, the Applicant arguments regarding multiple message segments and different background sounds are persuasive.

**Claim 9, 11, 14-15, 17-18, 20-24, 28, 90, 99, 116**, they depend from allowed claim 1.

**Claim 100**, the Applicant arguments regarding multiple message segments and different background sounds are persuasive.

**Claim 101-110**, they depend from allowed claim 100.

**Claim 111**, the Applicant arguments regarding multiple message segments and different background sounds are persuasive.

**Claim 112-113**, they depend from allowed claim 111.

#### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hemant Patel whose telephone number is 571-272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Hemant Patel  
Examiner  
Art Unit 2614

HSP

*HSP*

  
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SUPERVISORY PATENT EXAMINER  
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